REMARKS:

In the outstanding Office Action, the Examiner rejected claims 1-21. Claims 1-21 are amended herein. The claim amendments are supported at least at page 3, lines 1-3, 16-21; page 7, lines 1-20, line 28 through page 8, line 4, lines 5-22 and page 11, lines 2-11, lines 7-27. No new matter is presented. Thus, claims 1-21 are pending and under consideration. The rejections are traversed below.

REJECTION UNDER 35 U.S.C. § 112¶2:

Claims 1-21 were rejected under 35 U.S.C. § 112¶2. Claims 1-21 are amended herein to comply with the requirements of § 112¶2.

Therefore, withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 101:

Claims 8-14 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Examiner asserts that the claimed invention in claims 8-14 are non-tangible and do not provide a useful, concrete and tangible result. Independent claim 8, as amended, is directed to a search program embodied on a computer-readable medium causing a computer to perform operations to facilitate a search, which is a useful, tangible, and concrete result (claims 9-14 depend on claim 8).

MPEP §2106 states that subject matter outside patentable statutory subject matter is limited to abstract ideas, laws of nature, and natural phenomena, where the claimed subject matter is not a *practical application or use* of an idea, a law of nature or a natural phenomena. Thus, a claim to an "abstract idea" is non-statutory when it does not represent a practical application of the idea. A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result (see, MPEP § 2106).

As recited in amended independent claim 8, the user is presented with "said search word, said extracted synonym" and evaluation data of both in a "selectable" manner and presented with data concerning "an identified document including the selected search word or the selected synonym." Accordingly, a concrete, tangible and useful result is achieved not only by executing the search but also by assisting a user in selecting evaluation data that ensures results tailored to the search word designated by the user. (see, State Street Bank & Trust Co. v. Signature Financial Group Inc., 47 U.S.P.Q.2d 1596 (Fed. Cir. 1998)).

Thus, it is respectfully submitted that because independent claim 8 and dependent claims dependent therefrom satisfy the requirements of 35 USC §101, withdrawal of the rejection is requested.

REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1-3, 5, 6, 8-10, 12, 13, 15-17, 19 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,692,176 (Holt).

Holt retrieves documents containing search terms and ranks the documents based on a formula that varies according to the square of the frequency in each of the text documents of each of the search terms. In Holt, a user selects a search description from a list of terms (152) for which equivalent terms are desired (see, Fig. 12 and corresponding text). However, Holt does not teach or suggest presenting the user with the evaluation data "of the extracted synonym" as taught by the claimed invention (see detailed discussion of claims below).

Moreover, according to Holt, equivalents for the terms are provided by the user after the user has selected the third (thesaurus) option (116) and provided selected equivalent terms for particular terms in the search description (112b) (see, col. 7, line 66 through col. 8, line 2). That is, Holt is limited to providing the thesaurus or the search descriptions *before* starting the search.

The claimed invention not only conducts searches, but also guides a user in obtaining the best search results by providing the evaluation data (for example, before the synonym is selected by the user) representative of relevancy between the documents to be searched and the extracted synonym.

Independent claim 1 recites "extracting a synonym of said search word from a synonym file", "obtaining evaluation data of said search word" that is at least either "a score based on an appearance frequency of said search word and a number of documents including said search word" and "evaluation data of the extracted synonym" that is at least either of "a score based on an appearance frequency of said extracted synonym and a number of documents including said extracted synonym." Claim 1 further recites, "presenting said search word, extracted synonym, evaluation data of said search word, and said evaluation data of said extracted synonym in a manner in which said search word and synonym are selectable" and providing an identified document including "the selected search word or the selected synonym."

Similarly, independent claims 8 and 15 recite, "extracting a synonym of said search word from a synonym file" and "obtaining evaluation data" of the search word which is either of "a score based on an appearance frequency of said search word and a number of documents

including said search word" and evaluation data of the extracted synonym which is either of "a score based on an appearance frequency of said extracted synonym and a number of documents including said extracted synonym." Claims 8 and 15 further recite presenting the search word, the extracted synonym and evaluation data of both in a "selectable" manner and presenting the user with data concerning "an identified document including the selected search word or the selected synonym."

Holt does not teach or suggest each and every feature of independent claims 1, 8 and 15 discussed above, including "extracting a synonym of said search word from a synonym file", "obtaining evaluation data..." of both the word and the extracted synonym in "selectable" manner and presenting "an identified document including the selected search word or the selected synonym" by the user.

It is submitted that the independent claims are patentable over Holt.

For at least the above-mentioned reasons, claims depending from the independent claims are patentably distinguishable over Holt. The dependent claims are also independently patentable. For example, as recited in claim 3, "counting either said number of documents including said search word" and "said extracted synonym" or "a first appearance frequency" of "said search word in said documents including said search word" and "said extracted synonym in said documents including said extracted synonym by searching documents by using said search word and said extracted synonym" (see also claims 10 and 17 reciting similar features).

Holt does not teach or suggest a search including "counting either said number of documents including said search word" and "said extracted synonym" or "a first appearance frequency" of the search word and extracted synonym in said documents including the search word and the extracted synonym, as recited in claims 3, 10 and 17.

Therefore, withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 4, 7, 11, 14, 18 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Holt in view of U.S. Patent No. 6,473,753 (Katariya).

The Examiner acknowledges that Holt fails to disclose counting multiple appearance frequencies and using them to calculate a score, but relies on Katariya as teaching the same. However, Katariya is directed to calculating the importance of a term within a document based

on a computed normalized term frequency and a computed inverse document frequency (see, col. 3, lines 4-25).

Dependent claim 4, by way of example, recites, "calculating said score based on said appearance frequency of said search word using said second appearance frequency of said search word and said first appearance frequency of said search word" and "said score based on said appearance frequency of said extracted synonym using said second appearance frequency of said search word and said first appearance frequency of said extracted synonym." Claims 11 and 18 recite similar features.

Holt and Katariya do not teach or suggest the above-discussed features of claims 4, 11 and 18 including "calculating" the score based on "said appearance frequency" of said search word and extracted synonym using "said second appearance frequency of said search word and said first appearance frequency of said search word" and "said second appearance frequency of said search word and said first appearance frequency of said extracted synonym."

Holt and Katariya, alone or in combination, do not teach or suggest the claims search system and method, and for at least the above-mentioned reasons, claims depending from the independent claims are patentably distinguishable over Holt and Katariya.

Therefore, withdrawal of the rejection is respectfully requested.
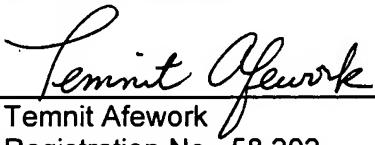
CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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